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OFFICE OF PETITIONS

In re Application of
McDaniel, et al. :
Application No. 10/696,946 :
Filing Date: 30 October, 2003 :
Attorney Docket No. ITL.1007US (P15532) :

This is a decision on the petition filed on 19 July, 2004, to revive the instant application 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) **DISMISSED as moot**, and the petition fee is refunded via Treasury check.

BACKGROUND

The record reflects that:

- Petitioner filed an Information Disclosure Statement (IDS) on 17 February, 2004;
- Notice of Allowance was mailed on 1 March, 2004, with reply due under a non-extendable deadline on or before 1 June, 2004, however, the Examiner did not address the IDS prior to or at Allowance;
- Petitioner filed an after-final amendment, in this case an amendment under 37 C.F.R. §1.312, on 12 March, 2004, and supplemented that filing on 25 March, 2004;
- on 1 June, 2004, Petitioner filed a Request for Continued Examination (RCE), with fee, and cited the amendment under 37 C.F.R. §1.312 as his submission;

- the Office mailed a Notice of Improper REC on 29 June, 2004 (the 29 June Notice);
- on 12 July, 2004, the Examiner issued a Supplementary Notice of Allowance, however, that action addressed Petitioner's filing of the 17 February, 2004, IDS and not the RCE filed on 1 June, 2004, in concert with the amendment filed on 12 and 25 March, 2004;
- on 19 July, 2004, Petitioner again filed an RCE (with fee and submission), as well as the instant petition (and fee) and request for extension of time (and fee);
- on 10 August, 2004, Petitioner sought the refund of the fee for the extra RCE fee paid.

The record does not indicate that Petitioner abandoned the instant application, and, while the Office may have mailed the 29 June Notice in error, the Office has not held the application abandoned.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing

¹ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

Allegations as to Unintentional Delay


As indicated above, the application was not abandoned by Petitioner and was not so deemed by the Office. Thus, it is a pending application, and it is being returned to the Technology Center for consideration of the RCE with the amendment filed 12 March and re-asserted on 25 March, 1 June and 19 July, 2004.

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The file is released to the Examiner in Technology Center 2800 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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Office of Petitions

⁴ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.